

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN DEMAYO and ROBERT AGUILAR

Appeal 2007-2053
Application 09/711,261
Technology Center 3600

Decided: October 29, 2007

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and DAVID B.
WALKER, *Administrative Patent Judges*.

WALKER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-32. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We reverse.

THE INVENTION

Appellants claim a system and method for enabling a party with content or dialogue text or HTML to hyperlink certain words or phrases to advertisers, in exchange for compensation for this advertising service, in real-time, as published, or on a periodically refreshed basis (Specification 1:3-5). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. An apparatus for hyperlinking specific words in content to convert the words into advertisements, comprising
 - an Internet-enabled web browsing device, including a terminal for connection to the Internet;
 - a content provider server having content files to be displayed on web browsers, said content provider server being connected to the Internet;
 - an advertiser web page accessible over the Internet; and
 - an ad server connected to the Internet, wherein the ad server provides means for providing a hypertext anchor to convert at least one existing advertiser-chosen word present in a content file into an advertisement by linking said at least one advertiser-chosen word to said advertiser web page.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Bull
Murray

US 5,995,943
US 6,061,659

Nov. 30, 1999
May 9, 2000

Kirsch

US 6,189,030 B1

Feb. 13, 2001

The following rejections¹ are before us for review.

1. Claims 1, 2, 4-6, 9, 10, 12, 13, 21, 24, and 31 stand rejected under 35 U.S.C. § 102(e) as anticipated by Bull.
2. Claims 3, 7, 11, 14, 15, 22, and 25 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bull.
3. Claims 8, 16, 23, and 26 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bull in view of Kirsch.
4. Claims 17-19, 27-29, and 31 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bull in view of Murray.
5. Claims 19, 20, 29, 30, and 32 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bull in view of Murray and further in view of Kirsch.

ISSUE

The issue before us is whether Appellants have shown that the Examiner erred in rejecting (1) claims 1, 2, 4-6, 9, 10, 12, 13, 21, 24, and 31 as anticipated by Bull; (2) claims 3, 7, 11, 14, 15, 22, and 25 as unpatentable over Bull; (3) claims 8, 16, 23, and 26 as unpatentable over Bull in view of Kirsch; (4) claims 17-19, 27-29, and 31 as unpatentable over Bull in view of Murray; and (5) claims 19, 20, 29, 30, and 32 as unpatentable over Bull in view of Murray and further in view of Kirsch. The dispositive issue is whether the cited references disclose “providing a

¹ The Examiner withdrew a rejection of claims 1-30 under 35 U.S.C. § 112, first paragraph in the Answer (Answer 3).

hypertext anchor to convert at least one existing advertiser-chosen word present in a content file into an advertisement by linking said at least one advertiser-chosen word to said advertiser web page.”

Rather than repeat the arguments of Appellants and the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

FINDINGS OF FACT

We find the following enumerated findings to be supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427, 7 USPQ2d 1152, 1156 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Bull teaches an information aggregation and synthesization system that facilitates user access to local information or information in a network. This information is topically oriented, composed of files and file references using HTML that may be prescreened for relevance and appropriateness. Bull discloses that selected text may be expanded at any time to provide other information. These words thus are linked to other documents and the information is indexed in advance of the user's logging in (Bull, col. 3, ll. 44-59).

2. According to Bull, the user will be presented with advertisements and/or coupons based on criteria entered by advertisers. This criteria may take the form of simple logic, linking an ad/coupon with a display or be derived from complex software test search agents that analyze one or more of the following: The user's looking pattern, the user's psychographic profile, the user's personal profile, the availability of the advertiser's/couponer's goods or services at the instant in time that the criteria is being exercised. The placement of the ad/coupon will be logged along with user profile information and provided to the advertiser/couponer in some form of report (Bull, col. 4, ll. 28-39).
3. Bull states that the world wide web datastore information is modified for users with limited band width by identifying, eliminating, and replacing any graphics files with a text anchor (Bull, col. 7, ll. 44-47).
4. Advertisers use a user access system to enter criteria that should be met to place an advertisement/coupon. This includes a match threshold. When the threshold is met or exceeded, an ad/coupon will be appended to a system session. Advertisers also can input hot links to be displayed with ads/coupons or geographic map displays (Bull, col. 8, ll. 3-22).
5. Bull also teaches ad/coupon insertion agents that are complex software test search patterns that when matched within the text being reviewed within a given session, cause an advertisement/coupon to be added into the display (Bull, col. 12, ll. 12-17). An analysis of the text of the user's interactive session will be performed online. When certain text patterns

are observed (or close matches are observed), an advertisement is inserted into the display. “As an example, if the user accesses web pages for ‘Holiday Inns on the West Coast’, the insertion mechanism would be established to automatically insert ads for ‘Hilton Inns on the West Coast’.” (Bull, col. 15, ll. 25-42).

6. Bull does not teach means for providing a hypertext anchor to convert at least one existing advertiser-chosen word present in a content file into an advertisement by linking said at least one advertiser-chosen word to said advertiser web page.
7. Kirsch teaches a system for reliably tracking and redirecting hyper-link references to external server systems (Kirsch, col. 5, ll. 14-16). The embedded hyperlink is associated with a graphical banner or other Web page element that is selectable, or clickable, by a user of the client system (Kirsch, col. 6, ll. 51-54). The data terms of the embedded redirection URL may be dynamically selected based on the identity of the advertiser and graphics image in addition to separately establishing a hypertext link to the graphics image as part of an instance of serving a particular web page by an HTTPd server (Kirsch, col. 9, ll. 10-15).
8. Kirsch does not teach means for providing a hypertext anchor to convert at least one existing advertiser-chosen word present in a content file into an advertisement by linking said at least one advertiser-chosen word to said advertiser web page.

9. Murray teaches that Internet advertising typically consists of a “banner” appearing in/or with documents and other information selected by the user. The object is for the user to click on the advertiser’s banner to access the advertiser’s information selected by the user (Murray, col. 2, ll. 2-7). According to Murray, approximately fifty-percent of Internet advertising appears in web browsers and search engines. Murray further discloses a prior art method of displaying a web page having a link to a hypertext document located at a remote server (Murray, col. 2, ll. 11-23).
10. Murray teaches a method for including an advertising message into the content, which “substantially improves the level of attention afforded the message by the user” (Murray, col. 3, ll. 5-7). The system of one embodiment of Murray includes means for retrieving the specified content from a content memory and means for identifying the predetermined specifications for substituting a portion of the content into a transformed representation of the predetermined message (Murray, col. 3, ll. 41-47). The programmed messages may take the form of static or animated icons, 2D and 3D graphics and animation, text, audio recordings or any object that may stand alone or be imbedded (Murray, col. 8, ll. 25-29).
11. Murray does not teach means for providing a hypertext anchor to convert at least one existing advertiser-chosen word present in a content file into an advertisement by linking said at least one advertiser-chosen word to said advertiser web page.

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications “not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (en banc) (*quoting In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004)). The properly interpreted claim must then be compared with the prior art.

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of ordinary skill in the art, and (4) where in evidence, so-called secondary

considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

ANALYSIS

A. Rejection of claims 1, 2, 4-6, 9, 10, 12, 13, 21, 24, and 31 under 35 U.S.C. § 102(e) as anticipated by Bull.

Appellants argue that Bull does not teach a conversion of an existing word in a content file into an advertisement, asserting that, according to Bull, an “ad is inserted based on the content of the existing web page being read” and is inserted as a new piece of information (Br. 13). The Examiner found that Bull teaches

wherein the ad server provides *hot links* (col. 8 line[s] 19-21), which reads on hypertext links or hyperlinks (Microsoft Press Computer Dictionary), to convert at least one existing word (e.g., *Holiday Inns on the West Coast*, col. 15 lines 39-42) present in a content file into one or more advertisements (e.g., an ad for *Hilton Inns on the West Coast*) by linking an Internet-enabled web browsing device (*network addressable interface device*, col. 3 lines 28-29) connected to the Internet to said advertiser web page (col. 15 lines 30-33).

(Answer 4). Bull is directed to a system for monitoring the user’s surfing patterns and inserting ads that are related to the user’s search/surfing patterns (Findings of Fact 1 and 2). Bull does not teach means for providing a hypertext anchor to convert at least one advertiser chosen word by linking the at least one word to an advertiser web page as required by claim 1 (Finding of Fact 6). Independent

claims 9, 21, 24, and 31 each require the inclusion of a hypertext anchor for the essentially the same purpose. Because claims 1, 2, 4-6, 9, 10, 12, 13, 21, 24, and 31 each require the missing hypertext anchor limitation, either directly or via dependency, the Examiner failed to make out a prima facie case of anticipation of each of the those claims.

B. Rejection of claims 3, 7, 11, 14, 15, 22, and 25 under 35 U.S.C. § 103(a) as unpatentable over Bull.

Each of claims 3, 7, 11, 14, 15, 22, and 25 depend from one of independent claims 1, 9, 21, or 24, each of which require the hypertext anchor limitation addressed in connection with the foregoing anticipation rejection. Because Bull does not teach converting at least one advertiser chosen word by linking the at least one word to an advertiser web page, the Examiner failed to make out a prima facie case of obviousness as to independent claims 1, 9, 21, and 24. Dependent claims 3, 7, 11, 14, 15, 22, and 25 therefore are nonobvious as depending from a nonobvious independent claim. See *In re Fine*, 837 F.2d 1071, 5 USQP2d 1596 (Fed. Cir. 1988) (If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim dependent therefrom is nonobvious).

C. Rejection of claims 8, 16, 23, and 26 under 35 U.S.C. § 103(a) as unpatentable over Bull in view of Kirsch.

Because each of claims 8, 16, 23, and 26 depend from an independent claim that is nonobvious over Bull, and Kirsch does not remedy the deficiencies of Bull discussed above (Finding of Fact 8), the Examiner failed to make out a prima facie case of obviousness over Bull and Kirsch as to claims 8, 16, 23, and 26.

D. Rejection of claims 17-19, 27-29, and 31 under 35 U.S.C. § 103(a) as unpatentable over Bull in view of Murray.

Claims 17, 27, and 31 are independent claims that also include a comparable hypertext anchor limitation that is missing from Bull. Each of claims 18-19 and 28-29 depend from an independent claim that is nonobvious over Bull. Because Murray does not remedy the deficiencies of Bull discussed above (Finding of Fact 11), the Examiner failed to make out a prima facie case of obviousness over Bull and Murray as to claims 17-19, 27-29, and 31.

E. Rejection of claims 19, 20, 29, 30, and 32 under 35 U.S.C. § 103(a) as unpatentable over Bull in view of Murray and further in view of Kirsch.

Because each of claims 19, 20, 29, 30, and 32 depend from an independent claim that is nonobvious over Bull and neither Murray nor Kirsch remedy the deficiencies of Bull discussed above (Findings of Fact 8 and 11), the Examiner failed to make out a prima facie case of obviousness over Bull, Murray, and Kirsch as to claims 19, 20, 29, 30, and 32.

REMAND

We remand this application to the Examiner for consideration of whether the combination of Bull in combination with the cited prior art and other available prior art renders obvious the subject matter of claims 1-32. The first three limitations of claim 1, namely 1) an Internet-enabled web browsing device, including a terminal for connection to the Internet; 2) a content provider server

having content files to be displayed on web browsers, said content provider server being connected to the Internet; and 3) an advertiser web page accessible over the Internet, each of which was well known in the art at the time of the claimed invention, are not in dispute. However, the Examiner improperly relied on Bull's teaching of a system of serving banner ads based on the user's web-browsing habits (Finding of Fact 2) as anticipating an ad server which provides means for providing a hypertext anchor to convert at least one existing advertiser-chosen word present in a content file into an advertisement by linking said at least one advertiser-chosen word to said advertiser web page as required by claim 1, and with minor variations, each of the other pending claims. Because this reliance is the basis for all of the rejections on appeal, we cannot sustain any of the rejections.

However, the extent to which the missing limitation would have been obvious to one of skill in the art in light of the prior art of record and other available art is not clear. Accordingly, we remand this application to the Examiner to consider whether it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the teaching of Bull to incorporate an ad server that provides means for providing a hypertext anchor to convert at least one existing advertiser-chosen word present in a content file into an advertisement by linking said at least one advertiser-chosen word to said advertiser web page.

CONCLUSIONS

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1, 2, 4-6, 9, 10, 12, 13, 21, 24, and 31 under 35 U.S.C. § 102(e).

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We conclude that Appellants have shown that the Examiner erred in rejecting claims 3, 7, 8, 11, 14-20, 22, 23, and 25-32 under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner to reject claims 1, 2, 4-6, 9, 10, 12, 13, 21, 24, and 31 under 35 U.S.C. § 102(e) is reversed. The decision of the Examiner to reject claims 3, 7, 8, 11, 14-20, 22, 23, and 25-32 under 35 U.S.C. § 103(a) is reversed.

REVERSED AND REMANDED

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